

REMARKS

The Office Action dated March 8, 2006, has been received and carefully considered. Reconsideration of the outstanding objections/rejections in the present application is respectfully requested based on the following remarks.

THE NON-STATUTORY SUBJECT MATTER REJECTION OF CLAIMS 11 AND 13

On page 2 of the Office Action, claims 11 and 13 are rejected as allegedly being directed to non-statutory subject matter. Applicants respectfully submit that claim 13 has been amended to present a method and claim 11 recites an article of manufacture. Applicants respectfully submit that both categories are permitted by statute and applicants, therefore, traverse these rejections.

As an initial matter, Applicants incorporate herein by reference and maintain and reiterate the previous remarks filed in this application. Applicants have reviewed the current Office position on these types of claims (as expressed in 1300 OG 142 (Nov. 22, 2005)). In compliance with that policy, Applicants have amended claim 13 to express a method (i.e., process) as opposed to a signal. Applicants respectfully submit that both claims 11 and 13 contain statutory subject matter (e.g., article of manufacture and process). Applicants respectfully request that the rejections be withdrawn.

THE OBVIOUSNESS REJECTION OF CLAIMS 1-3, 5-8 and 10-12

On page 2 of the Office Action, claims 1-3, 5-8 and 10-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Piazza in view of McGuire. This rejection is hereby respectfully traversed for failing to disclose or suggest each claimed feature and for failing to provide appropriate motivation to combine the references. Again, Applicants incorporate herein by reference the previously filed remarks but, for brevity, do not repeat them here.

Furthermore, applicants respectfully submit that under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a prima facie case of obviousness. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Patent Office can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of references. Id. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). That is, under 35 U.S.C. § 103, teachings of references can be combined only if there is some suggestion

or motivation to do so. Id.. However, the motivation cannot come from the applicant's invention itself. In re Oetiker, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992). Rather, there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the art would make the combination. Id..

As stated in MPEP § 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Also, as stated in MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill

in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Further, as stated in MPEP § 2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). That is, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). Additionally, as stated in MPEP § 2141.02, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Finally, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

On page 4, the Examiner asserts that "applicant has failed to look at the whole motivation." The whole motivation, as

stated by the Examiner, is that the "modification would have been obvious because one of ordinary skill in the art would have been motivated to provide more choices to use when choosing an object oriented language like Scheme, Lisp and C++ as a development tools (sic) to develop the computer system." Office Action, p. 4. Applicants respectfully submit that the rejection is improper for the following reasons.

First, the Examiner admits that Piazza does not disclose the claimed C/C++ program. To repair this deficiency, the Examiner relies on McGuire to allegedly disclose the claimed C/C++ program. However, McGuire also does not disclose the claimed C/C++ program. Instead, McGuire discloses an "object oriented language from the Curl Corporation ... that has similar capabilities to those found in languages such as Scheme, Lisp and C++." Office Action of 4/7/05, p. 4-5 (quoting McGuire, 8:32-37). Thus, McGuire does not even disclose the claimed C/C++ program -- merely a language that has "similar capabilities" to C/C++. Applicants respectfully submit that the claims recite "a first C/C++ program." The Examiner has not provided any evidence that the Curl language disclosed in McGuire is a "first C/C++ program." In fact, McGuire himself says that it is not -- it is a language that has "similar capabilities" but it is not C/C++.

Second, even if McGuire can be considered to disclose the claimed "first C/C++ program" the Examiner has not provided proper motivation to combine Piazza and McGuire. Piazza discloses a compiler for Scheme/Lisp into CPS. See, abstract. McGuire discloses a system to create and manipulate variables. See, abstract. As quoted above, the Examiner is stating that one of ordinary skill in the art would have been motivated to modify the compiler of Piazza, with the system to create and manipulate variables of McGuire in order to "provide more choices to use when choosing an object oriented language like Scheme, Lisp and C++ as a development tools (sic) to develop the computer system." What the Examiner has not done is provide motivation why one of skill in the art would want to provide more choices to use when choosing an object oriented language as development tools to develop the computer system.

Applicants respectfully submit that neither of the "computer systems" disclosed in Piazza and McGuire disclose the use of any development tools. Thus, except for the Examiner's assertion, there is no suggestion to provide development tools in either system. Therefore, one of ordinary skill in the art would first have to be motivated to provide development tools and then be motivated to provide additional choices for those tools. This is simply not the case.

Furthermore, applicants respectfully point out that C/C++ was available at the time of Piazza, yet Piazza does not disclose that his compiler is usable with the C/C++ language. This in addition to applicants previously submitted remarks demonstrate that those skilled in the art recognize the associated difficulties in going from programming C/C++ to programming in Scheme and it is not an obvious matter to substitute one for the other.

Claim 13 is rejected by Piazza, McGuire and Bak. However, Bak is relied upon to allegedly disclose "a data signal embodied as a carrier wave" and, thus, does not cure the above-noted deficiencies of the proposed combination of Piazza and McGuire. For at least this reason Applicants respectfully request that the rejection of claim 13 be withdrawn.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 1-3, 5-8 and 10-13 be withdrawn.

X. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by

telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

Hunton & Williams LLP

By: 

Christopher J. Cuneo
Registration No. 42,450 for,
Thomas E. Anderson
Registration No. 37,063

Hunton & Williams LLP
1900 K Street, N.W.
Washington, D.C. 20006-1109
Telephone: (202) 955-1500
Facsimile: (202) 778-2201

Date: May 8, 2006